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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,236	04/13/2000	KEVIN W. CARLEY	AND1P405	7816

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EXAMINER


MORGAN, ROBERT W

ART UNIT PAPER NUMBER

3626

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/549,236	Applicant(s) CARLEY ET AL.	
	Examiner Robert W. Morgan	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Notice to Applicant

1. This communication is in response to the amendment filed 5/25/04. Claims 19-33 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 19, 21, 24, 26, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,267,155 to Buchanan et al. and U.S. Patent No. 5,410,551 to Edwards et al. in view of U.S. Patent No. 6,523,022 to Hobbs in view of U.S. Patent No. 6,535,883 to Lee et al., for the same reasons given in the previous Office Action (dated 2/26/04). Further reasons appear below.

(A) Claims 19, 21, 24, 26, 29 and 31 have not been amended, and are rejected for the same reasons given in the previous Office Action (dated 2/26/04), and incorporated herein. Further reasons appear hereinbelow.

4. Claims 20, 22-23, 25, 27-28, 30 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,267,155 to Buchanan et al. and U.S. Patent No. 5,410,551 to Edwards et al. in view of U.S. Patent No. 6,523,022 to Hobbs in view of U.S. Patent No. 6,535,883 to Lee et al. as applied to claim 19 above, and further in view of U.S. Patent No. 5,410,576 to Dauerer et al., for the same reasons given in the previous Office Action (dated 2/26/04). Further reasons appear below.

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(A) Claims 20, 22-23, 25, 27-28, 30 and 32-33 have not been amended, and are rejected for the same reasons given in the previous Office Action (dated 2/26/04), and incorporated herein. Further reasons appear hereinbelow.

Response to Arguments

5. Applicant's arguments filed 5/25/04 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 5/25/04.

(A) In the remarks, Applicants argue in substance that, (1) Stringing together a series of prior art references characterized as a "prior art mosaic" is in not enough for a rejection; (2) The four references of Buchanan et al., Edwards et al., Hobbs and Lee et al. solve four distinctly different problems and the Examiner cannot show any reasons that if confronted with the same problems would combine the references; and (3) The Examiner's motivation is merely hindsight, building a mosaic of prior art.

(B) In response to Applicants arguments that, (1) Stringing together a series of prior art references characterized as a "prior art mosaic" is in not enough for a rejection. The Examiner respectfully submits reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

(C) In response to Applicants arguments that, (2) The four references of Buchanan et al., Edwards et al., Hobbs and Lee et al. solve four distinctly different problems and the Examiner cannot show any reasons that if confronted with the same problems would combine the references. The Examiner respectfully submits that establishing a *prima facie* case of obviousness is determined on the basis of the evidence

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as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see: dated 2/26/04).

In addition, the Examiner recognizes obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Additionally, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is

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respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the prior Office Action (paper number 5), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Furthermore, it has been held that a prior art reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Firstly, the Examiner respectfully submits that the prior art references are in the field of Applicant's endeavor. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant's invention pertains to report creation and more particularly to compiling summary report during data load. The Examiner respectfully submits in this case that the primary reference, Buchanan et al. was relied upon for teachings loading data into a database utilizing a computer-assisted document generation system including a relational database (2, Fig. 1) used to manage document templates as well as storing, retrieving and manipulating data within the templates (see: column 5, lines 39-50). Buchanan et al. was further relied on for teaching selecting a data management template

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by making use of the templates created and selected by the user according to the type of report needed to accommodate a task (see: column 5, lines 5, 13-17). Edwards et al. was relied on for teaching the validating and loading all data loaded into the database and compiling reports identifying data that match the data management template and data that did not match the data management template using a network verification system including a comparing unit (180, Fig. 1) that detects mismatches between two lists of data items, first list (160, Fig. 1) and a second list (170, Fig. 1), also indicating any data item in the first list (160, Fig. 1) which do not having matching data item in the second list (170, Fig. 1) or vice versa and then records them in an error report (190, Fig. 1) (see: column 26, lines 38-56). Hobbs was relied upon for teaching a multi-tier client/server model for record retrieval from a database using linked words, phrases, sentences and paragraphs of text (see: column 1, lines 20-42). Lee et al. was relied upon for teaching a system and method for creating validation rules to confirm input data using validation rules program (15, Fig. 2) (see: column 5, line 65 to column 6, line 19). Thus, it is the position of the Examiner that Buchanan et al., Edwards et al., Hobbs and Lee et al. are in the field of the Applicant's endeavor (i.e., they relate to report generation and validation of data loads using an error report), and are therefore analogous art.

Secondly, the Examiner respectfully submits that the prior art references are reasonably pertinent to the particular problem with which the Applicant was concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Buchanan and Edwards are directed to solving the problem creating validation rules and validating data loads using reports and a multi-tier client/server model (see: Buchanan: column 5, lines 39-50, Edward: column 26, lines 38-56, Hobbs: column 1, lines 20-42 and Lee et al.:

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column 5, line 65 to column 6, line 19). The present application also seeks to solve a similar problem, namely, data inconsistencies, saving significant time when a system is unavailable and backup sites failure resulting in network partitions (see: page 6 lines 13-20 of specification). Thus, it is the position of the Examiner that the prior art references are reasonably pertinent to the particular problem with which the Applicant was concerned and the applied references are analogous art as they all relate to improving data inconsistencies in reporting over computer networks.

Moreover, it should be noted that the cited reference(s) was never applied as a reference under 35 U.S.C. 102 against the pending claims. As such, the Examiner disputes that Applicant's remarks that the four references solve four distinctly different problems from the Applicant. Additionally, it is respectfully submitted that if Applicant's were correct in his assertion which Examiner does not admit, it has been held that prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

(D) In response to Applicants arguments that, (3) The Examiner's motivation is merely hindsight, building a mosaic of prior art. The Examiner respectfully submits it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (703) 605-4441. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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